

applicant regards as the invention. More specifically, the use of the phrase “relatively short” has been objected to. The rejection under 35 U.S.C. § 112, second paragraph, is respectfully traversed. Reconsideration thereof is respectfully requested.

The second paragraph of Section 112 merely requires that the claims set forth and circumscribe a particular area with a reasonable degree of precision and particularity. The definiteness of the claim language employed must not be analyzed in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one having ordinary skill in the pertinent art. *Ex parte Moelands*, 3 USPQ2d 1474,1476 (PTO Bd. App. & Int’f 1987), quoting *In re Moore*, 169 USPQ 236, 238 (CCPA 1971). Additionally, the term “relatively” does not automatically render a claim indefinite. Instead, when a word of degree is used, one must determine whether, when read in light of the specification, the claim reasonably apprises one of skill in the art of the scope of the invention. See, e.g., *Ex Parte Oetiker*, 23 USPQ2d 1641, 1649 (PTO Bd. Pat. App. & Int. 1991).

Turning to the present specification, the phrase is “relatively short” is defined in the context of the exemplary implementations on page 9, lines 17-31. Applicant respectfully submits that one of skill in the art who has read claim 2 in light of the teachings of the prior art and the present specification would be reasonably apprised of the scope of the invention defined by claim 2. As such, claim 2 is definite and the rejection under 35 U.S.C. § 112, second paragraph, should be withdrawn. ?

### III. PRIOR ART REJECTION

#### A. The Rejection

Claims 1-8 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,584,872 to LaFontaine (the LaFontaine ‘872 patent). The rejection under 35 U.S.C. § 102 is respectfully traversed. Reconsideration thereof is respectfully requested.

## B. The Claimed Combinations

Independent claim 1 calls for a combination of elements comprising “a shaft,” “a **plurality of energy transmission devices** supported on the shaft” and “a tissue cooling apparatus supported on the shaft including an **outer member positioned about the plurality of energy transmission devices** such that a continuous fluid transmission space is defined therebetween having an inlet and an outlet.” Claims 2-8 depend from independent claim 1 and by definition include, *inter alia*, the combination of elements recited in claim 1.

## C. The LaFontaine '872 patent

The LaFontaine '872 patent discloses a variety of different RF energy treatment devices. Treatment device 10 is illustrated in Figures 1 and 2, treatment device 56 is illustrated in Figure 3, treatment device 66 is illustrated in Figure 4, treatment device 78 is illustrated in Figure 5, and treatment device 98 is illustrated in Figure 6. Each of the treatment devices includes a **single** electrode and a structure for conveying an electrolytic fluid past the electrode. More specifically, the treatment device 10 illustrated in Figures 1 and 2 includes a **single** cylindrical electrode 38, as does the treatment device 56 illustrated in Figure 3 and the treatment device 66 illustrated in Figure 4. Instead of an electrode 38, the treatment device 78 illustrated in Figure 5 includes a **single** electrode 89, which has a different configuration than the electrode 38. [Column 14, lines 28-47.] The treatment device 98 illustrated in Figure 6 includes a **single** electrode 102. Accordingly, and in contrast to the combination of elements set forth in independent claim 1, the LaFontaine '872 patent simply does not disclose a treatment device with a **plurality** of energy transmission devices.

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As the LaFontaine '872 patent fails to teach or suggest each and every element in the combination defined by independent claim 1, applicant respectfully submits that the rejection of claims 1-8 under 35 U.S.C. § 102 is improper and should be withdrawn.

#### IV. CLOSING REMARKS

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application are respectfully requested. Allowance of the claims at an early date is courteously solicited.

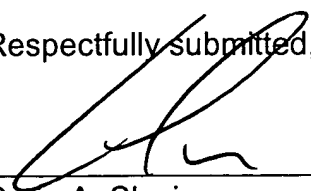
If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

12/7/02  
Date

**Henricks, Slavin & Holmes LLP**  
840 Apollo Street, Suite 200  
El Segundo, CA 90245  
(310) 563-1458  
(310) 563-1460 (Facsimile)

Respectfully submitted,

  
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Craig A. Slavin  
Reg. No. 35,362  
Attorney for Applicant